REMARKS

Applicants thank the Examiner for the courtesies extended to Applicants' representative during the Interview of December 28, 2004. Applicants believe that the Interview has advanced prosecution of the present application. Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing remarks.

In the present Reply, claims 2, 8, 22 and 23 have been amended. Claims 24-28 have been added. Thus, claims 2-3, 8 and 22-28 are pending in the present application.

No new matter has been added with these amendments and newly added claims. For instance, claim 2 as amended includes the term "solid" in describing the adhesive layer, as suggested by the Examiner (see the outstanding Office Action at page 3, lines 13-15). The dependencies of claims 8, 22 and 23 have been changed. New claims 26-28 reflect the same subject matter as claims 8, 22 and 23, but these new claims depend on claim 3. Support for new claims 24-25 can be found in the present specification in the paragraph bridging pages 21-22.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Substance of the Interview

In accordance with M.P.E.P. § 713.04, Applicants provide the following comments.

During the Interview of December 28, 2004, Applicants discussed how the cited JP 11-254656 reference discloses a foam layer 3 that is not the same as the instantly claimed adhesive layer. Applicants also proposed a comparative testing corresponding to Example 2 of JP 11-254656. These distinctions are discussed in more detail below.

Issues Under 35 U.S.C. § 112, First Paragraph

Claims 2, 8 and 20-23 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description (see paragraph 6). Applicants respectfully traverse.

Applicants have adopted the Examiner's suggested amendment. Thus, this rejection is rendered moot.

With regard to the claim language of "solid", this term does not encompass typical foamed products such as shown, e.g., in JP 10-180991. Further, in the context of the present invention, the term "solid" includes solid elastic adhesive materials. Also, it is recognized that during the preparation of typical solid adhesives, including the present invention, a small amount of fine or residual foam could be present even if no foaming (adjusting) agent is used. Thus, the "solid pressure-sensitive adhesive layer" of the present invention may contain fine foam

getting into the layer without such an intention during the manufacturing process, such as when applying and drying an adhesive solution in making the present invention.

Issues Under 35 U.S.C. § 112, Second Paragraph

Claims 2, 8 and 20-23 stand rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

The disputed term has been deleted from pending claim 2. Thus, this rejection is rendered moot. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 2, 3, 8, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11-254656 (computer translation; hereinafter referred to as "JP '656") (as stated in paragraph 6 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

Distinctions over JP '656

Applicants respectfully submit that a *prima facie* case of obviousness has not been formed with respect to the asserted

modification of JP '656 because not all requirements for a *prima facie* case of obviousness have been satisfied.

In the paragraph bridging pages 4-5 of the Office Action, the Examiner states that JP '656 has identical or substantially identical structure of composition. Applicants respectfully disagree, since JP '656 has been misinterpreted. The sheet of JP '656 as shown in the drawing (see computer translation, first page) has a foam layer itself exhibiting adhesiveness on its surface, and not a layer having a pressure sensitive adhesive coated on the surface of a foam layer as asserted in the Office Action. The disclosure supports this interpretation (e.g., see section (57) and paragraphs [0006]). As claimed, the present invention does not have its adhesive layer as a foamed layer. Thus, the structures and compositions of the JP '656 reference are not identical or substantially the same as the present invention, as asserted in the Office Action. In fact, JP '656 has a foaming layer with adhesive properties that is not instantly claimed.

Thus, Applicants submit this rejection has been overcome. U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of

a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Here, not even the first requirement of disclosure of all claimed features (i.e., solid adhesive layer) has been satisfied. Thus, this rejection has been overcome and withdrawal thereof is respectfully requested.

Applicants also submit that the requisite motivation and reasonable expectation of success are lacking. As mentioned, the sheet of JP '656 as shown in the drawing (see computer translation, first page) has a foam layer itself exhibiting adhesiveness on its surface. In this regard, if a proposal for modifying the cited reference in an effort to attain the claimed invention causes the reference to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *See In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (Federal Circuit stating that modifying the French apparatus as the Board suggested would render the apparatus inoperable for its intended purpose); *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *see also In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). That is the case here because the present invention would destroy the intended purpose of the JP '656 reference since the foamed layer would have to be

excluded in order to achieve the present invention. Thus, Applicants respectfully submit that the other requirements for a *prima facie* case of obviousness have not been satisfied. Reconsideration and withdrawal of this rejection are respectfully requested.

Unexpected Results of the Present Invention

Applicants submit herewith a Declaration pursuant to 37 C.F.R. § 1.132 by co-inventor Tsuyoshi Hiramatsu. The attached Rule 132 Declaration clearly shows the inferior results of the cited JP '656 reference. Both Examples A and B in the Declaration correspond to Example 2 of JP '656 (and not the present invention).

As illustrated in the Rule 132 Declaration, the adhesive sheet of JP '656 loses tackiness at the same time as absorbing the solvent (see Table 1 on page 3 of the attached Declaration). This is in contrast to the present invention, wherein the instantly claimed pressure-sensitive adhesive sheet still has sufficient tackiness remaining even after absorbing the predetermined amount of solvent. Accordingly, when the pressure-sensitive adhesive sheet of the present invention is peeled off from the article to be treated, the solidified matter after absorption of the solvent is stuck to the pressure-sensitive adhesive sheet and is removed from the treated article. In this regard, Applicants respectfully refer the Examiner to the scope of pending claims 2 and 3, as well as to the present specification at page 33, lines 13-22.

Information Disclosure Statement of September 26, 2003

Applicants are not in receipt of a copy of the PTO-1449 form that was submitted with the Information Disclosure Statement of September 26, 2003, showing the Examiner's initials next to each cited reference. Thus, Applicants respectfully request such a copy from the Examiner.

Conclusion

Applicants herein request reconsideration of all evidence of patentability on record, including the arguments of patentability presented herein and the attached Rule 132 Declaration, as required by M.P.E.P. § 2144.08(III).

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in

connection with the present application. The required fee of $1020.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
Gerald M. Murphy, Jr., #28,977

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

GMM/ETP
3273-0146P

Attachment:
Declaration pursuant to 37 C.F.R. § 1.132